



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,160	12/28/2000	Anthony B. Eoga	PA00-1010-Y	8687
7590	07/01/2004		EXAMINER	
STEVEN B. STEIN, ESQ. STEIN & STEIN 164 ROUTE 10 WEST SUCCASUNNA, NJ 07876			ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,160	EOGA, ANTHONY B.	
	Examiner	Art Unit	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-6,8-26 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-6,8-14 and 30-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-6, 8-14 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 is deemed to contain new matter in regards to the limitation: "wherein the polyethylene oxide has a molecular weight greater than 250,000". A detailed examination of the application shows absolutely no support for applicant's said polyethylene oxide molecular weight range of "greater than 250,000". The last line on page 8 through the first line on page 9 of the specification discloses polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000. The same polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000 is set forth on page 13, lines 13-17 of applicant's specification. If applicant desired to limit the polyethylene oxide molecular weight range too greater than 250,000, applicant will need to file another application as a CIP application.

Art Unit: 1714

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is indefinite do to the use of the modifier "about" before "250,000" since independent claim 1 from which claim 8 depends requires that the polyethylene oxide has a molecular weight of greater than 250,000.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 3-6, 8, and 11-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roth et al. U.S. patent Number 5,418,006.

Roth et al discloses a method for coating a substrate surface with an aqueous composition comprising a film-forming substance, a water repelling substance and optional adjuvants such as surfactant, see column 2, line 23 to column 3, line 68. The coating can be removed with water and can be used to protect the coated surface from graffiti, see the abstract, column 4, line 28 to column 5, line 66, column 5, line 67 to column 6, line 6. Applicant's claims are deemed to be anticipated over Examples 4-5 wherein carboxymethylcellulose is used as the film-forming substance in the surfactant containing aqueous coating composition used to coat the substrate. In the alternative, Roth et al may differ from applicant's claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose used in Examples 4-5. In the case that Examples 4-5 use a carboxymethylcellulose having a molecular weight that is outside of applicant's claimed range of "greater than 250,000" such would be obvious since carboxymethylcellulose agents are notoriously well known in the art to have molecular weights greater than 250,000, and such a molecular weight range is deemed to come directly within the broad disclosure of the patent. In any case the Examples 4-5 were given by way of illustration and not by way of limitation.

8. Claims 9-10 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. U.S. patent Number 5,418,006.

Roth has been described above and this rejection builds thereon. Roth differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a coating composition that actually comprises a coloring agent (claim 9), a fragrancing agent (claim 10), or one of applicant's specifically claimed polyethylene oxide species or surfactant species, as set forth in new claims 30-33.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Roth as set forth in column 2, line 23 to column 4, line 65 as motivation to actually make a coating composition that comprises a coloring agent, a fragrancing agent, or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent. Please note that Roth's optional metal oxides, such as titanium oxide, see column 4, lines 16-29, are well known pigments.

9. Claims 1, 3-6, and 8-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murayama U.S. Patent Number 5,401,495.

Murayama teaches a three-component system to whiten teeth and a method of its use, see column 2, line 52 to column 7, line 35. Applicant's invention is deemed to be anticipated over Example 4 when the "Polishing and

"Pigmenting Cream" is applied to the teeth of a person. It must be noted that the "Polishing and Pigmenting Cream" contains in part: carboxymethylcellulose 7MP and components that can be considered to be surfactants. In the alternative, Murayama may differ from applicant's claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose 7MF component used in Example 4. In the case that the carboxymethylcellulose 7MF used in Example 4 has a molecular weight that is outside of applicant's claimed range of "greater than 250,000", it would be obvious to use another carboxymethylcellulose agent having a molecular weight greater than 250,000 since such molecular weight ranges are notoriously well known in the art, and such a molecular weight range is deemed to come directly within the broad disclosure of the patent. In any case the Example 4 was given by way of illustration and not by way of limitation.

10. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama U.S. Patent Number 5,401,495.

Murayama has been described above and this rejection builds thereon. Murayama differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a coating composition that actually comprises one of applicant's specifically claimed polyethylene oxide species or surfactant species as set forth in new claims 30-33.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Murayama as motivation to actually make a coating

composition that comprises or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent.

11. Claims 1, 3-6, 8-14 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek U.S. Patent Number 4,861,583.

Sramek teaches aqueous hot curling hair treatment compositions that comprise water soluble polyethylene oxide polymer that have a molecular weight between about 20,000 to about 250,000, see abstract and claim 1. The hair treatment compositions can be washed out of the hair with water at any time. Optional adjuvants are surfactants wetting agents, dyes, perfumes etc., see column 3, lines 30-61. Sramek differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a hair treatment composition that actually comprises a water soluble polyethylene oxide that has a molecular weight of greater than 250,000. Likewise, applicant's specifically claimed polyethylene oxide species and surfactant species are not directly taught (i.e. by way of an example).

It would have been obvious to one having ordinary skill in the art to actually make and use a hair treatment composition that contained a water-soluble polyethylene oxide polymer having a molecular weight greater than 250,000 since Sramek directly discloses and claims the use of polyethylene oxide within a range of between 20,000 and about 250,000. Sramek's use of the

modifier "about" clearly expands Sramek 's disclosure to encompass polyethylene oxides which have molecular weights somewhat in excess of 250,000.

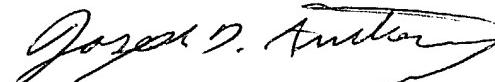
It would also have been obvious to one having ordinary skill in the art to use the broad disclosure of Sramek as motivation to actually make a coating composition that comprises or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent.

Prior-Art Cited But Not Applied

12. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.


Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

6/26/04